

REMARKS

Status of the claims

Claims 1-3, 5-7, 9-12, 14-17, 21, 22, 24-34 and 38-41 are pending in the application. By this amendment, claims 1, 3, 6, 7, 9, 10, 16, 17, 21, 25-27, 29 and 33 are amended; and claims 22, 24, 30-32, 34, 38, 40, and 41 are cancelled. Thus, following entry of this amendment, claims 1-3, 5-7, 9-12, 14-17, 21, 25-29, 33, and 39 are pending. Support of amendment of claims 1, 10, and 25 is found in the specification on, *inter alia*, page 27, lines 31-36.

With respect to all claim amendments and cancellations, Applicant has not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicant reserves the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional application.

Allowable claims

Applicant thanks the Examiner for allowing claims 1, 2, 6, 10-12, 14, 15, 21, 22, 25, 30 and 32.

Information Disclosure Statement

Applicant thanks the Examiner for having considered Information Disclosure Statement filed on 11/19/03. Applicant notes that a supplemental Information Disclosure Statement is submitted under separate cover. Applicant respectfully requests the Examiner consider the references and initial the form 1449.

Priority

The Examiner states that this application filed under former 37 CFR 1.60 lacks the necessary reference to the prior applications and the current status of the nonprovisional application referenced is not included.

Applicant notes that the specification is amended to include necessary reference to the prior applications and the current status of the nonprovisional parent application referenced.

Claim Objections

Claims 16, 17, 33, and 34 are objected as allegedly having informalities for reciting "an AAV packaging cell". The Examiner states that the phrase "an AAV packaging cell" is a grammatically improper phrase for a dependent claim and suggests amending the phrase to recite "the AAV packaging cell". The Examiner further states that claims 39 and 40 are objected to because they depend on claims 33 and 34.

Without acquiescing or conceding to the correctness of the objection, Applicant notes that claims 16, 17, and 33 are amended to recite "the AAV packaging cell" as suggested by the Examiner, and claim 34 is cancelled. Applicant respectfully requests withdrawal of this objection.

The Examiner also states that "should claim 16 be found allowable, claims 17, 24, 33, 34, and 38 will be objected to under 37 CDR 1.75 as being a substantial duplicate thereof". The Examiner further objects to claims 39, 40 and 41 because these claims depend from claim 33, 34, and 38, respectively.

Without acquiescing or conceding to the correctness of the objection, Applicant respectfully notes claims 24, 34, 38, 40, and 41 have been cancelled. Applicant respectfully submits that claims 17 and 33 have difference in scope compared to claim 16. MPEP §706.03(k) provides that "court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways" and "a mere difference in scope between claims has been

held to be enough". Applicant notes that the packaging cell in claims 16, 17, and 33 are different in scope. Claim 17 recites that "the AAV packaging cell comprises the stably integrated rAAV vector", and claim 16 recites that "the AAV packaging cell comprises the rAAV vector". Since claim 16 includes both stably integrated and non-stably integrated rAAV vector, claim 17 is different from claim 16 in scope. Applicant also notes that claim 33 recites "wherein said packaging cell grows at least one half as rapidly as parental-type cells that do not contain an AAV rep gene, and wherein said packaging cell when used to package rAAV vectors produces at least 100 rAAV particles/cell", which is not recited in claim 16. Thus, claim 33 is different from claim 16 in scope. In view of the above, Applicant respectfully submits that claims 17 and 33 should not be objected as being a substantial duplicate of claim 16. Applicant respectfully requests withdrawal of the objection to claims 17, 33, and 39.

For the above-stated reasons, withdrawal of these objections is respectfully requested.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 3, 5, 7, 9, 26, 27, 28, 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner states that the term "said packaging cell" on line 2 of claims 3 and 27 has insufficient antecedent basis and suggests replacing the term "said packaging cell" with the term "said mammalian cell". The Examiner also states that claims 5, 7, and 9 are indefinite because they depend on claim 3, and claims 28 and 29 are indefinite because they depend on claim 27. The Examiner also states that the term "said helper virus" on line 1 of claim 26 has insufficient antecedent basis and claims 28 and 31 are indefinite because they depend on claim 26.

Without acquiescing or conceding to the correctness of the objection, Applicant notes that claims 3 and 27 are amended to replace "said packaging cell" with the term "said mammalian cell" as suggested by the Examiner. Applicant also notes that claim 26 is amended to recite "said helper

virus-inducible expression of said stably integrated AAV rep gene is inducible by adenovirus" which has sufficient antecedent basis in claim 25.

In view of the above, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 226272001403. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 17, 2004

Respectfully submitted,

By 
Jie Zhou

Registration No.: 52,395
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5922